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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Michael C. Bailey et al.	:	Lewis A. Bullock, Jr.
Serial No.: 09/628,367	:	Group Art Unit: 2195
Filed: July 31, 2000	:	
	:	
Title: METHOD, PROGRAM PRODUCT	:	IBM Corporation
AND COMPUTER SYSTEM FOR	:	P.O. Box 12195
PROGRESSIVE IMPROVEMENT	:	Dept. T81/503
OF AN ENVIRONMENT POOL	:	Research Triangle Park, NC 27709

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated June 27, 2006, with a two-month statutory period for response set to expire on August 27, 2006.

I. RESPONSE TO EXAMINER'S ARGUMENTS

- A. Response to Examiner's argument that Curtis and Yokote, taken together, teach "responsive to initiation of a second program, making a determination whether creation of a new environment is a best response" as recited in claim 1 and similarly in claim 11, as discussed on pages 7-9 of Examiner's Answer.

The Examiner states:

Applicants agree that Curtis teaches determining whether or not the task can utilize a reusable OME, wherein if a reusable OME such that if a reusable OME is not available one is started (see page 8, lines 19-28 and figure 4 of Curtis). Curtis further states prior approaches allowed starting of the environments wherein each time an environment is started or invoked, some amount of initialization or instantiation is required of objects and their associated classes (col. 1, lines 16-39). Curtis improved upon the prior approach by maintaining some existing environments, however, if the environment was not compatible with the task, another environment would have to be started (col. 1, line 40 – column 2, line 5). Appellants maintain that the determining whether a reusable OME can be used for a task is not the same as determining whether the creation of a new environment is the best response. Section (a) of 35 U.S.C. 103, details that a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Examiner's Answer, pages 7-8.

Appellants respectfully traverse the assertion that Appellants allegedly asserted on page 8, lines 19-28 of Appellants' Third Appeal Brief that Curtis taught that if a reusable OME is not available that one is started. Appellants did not make such an assertion. Appellants respectfully assert that column 5, line 46 – column 6, line 6 of Curtis (passage cited by the Examiner that allegedly teaches the above-cited claim limitation) does not teach that if a reusable OME is not available that one is started.

Appellants further contest the Examiner's assertion that column 1, line 40 – column 2, line 5 of Curtis teaches that if the environment was not compatible with the

task, another environment would have to be started. Instead, column 1, line 40 – column 2, line 5 of Curtis teaches an existing environment is then utilized if the collection of parameters specifying the environment meets the minimal requirements of the second application, wherein data processing efficiency is increased.

Appellants further traverse the Examiner's conclusion that the difference between what is taught in Curtis and what is claimed in claims 1 and 11 would have been obvious to one of ordinary skill in the art. The Examiner has not provided any such evidence. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to establish a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's has not established a *prima facie* case of obviousness in rejecting claims 1 and 11. *Id.*

The Examiner further states:

Therefore, a determining step of whether a reusable object environment can be used and if not creating a new object environment would clearly be obvious to one of ordinary skill in the art as a way of determining whether creating an object environment is a best response. Although applicant's specification details what such determining would consist of and many be different from what one of ordinary skill in the art would consider such to be, the reading in of these limitations to interpret the "steps of" claims is improper under M.P.E.P. 2111 and 2181. It appears that this argument is based on how Applicant performs such in the specification and not at the level of one of ordinary skill in the art. Examiner's Answer, page 8.

Appellants respectfully assert that the citing of M.P.E.P. §§2111 and 2181 do not support the Examiner's basis that either Curtis teaches the above-cited claim limitation or that the above-cited claim limitation would have been obvious to one of ordinary skill in the art.

Additionally, Appellants respectfully traverse the Examiner's assertion that Appellants are reading in limitations from the Specification. Appellants merely assert that Curtis does not teach "responsive to initiation of a second program, making a

determination whether creation of a new environment is a best response." Appellants' Third Appeal Brief, pages 8-9. The Examiner has not cited to any passage in Curtis that teaches the above-cited claim limitation. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 11, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellants further traverse the Examiner's assertion that Appellants' arguments in Appellant's Third Appeal Brief are based on Appellants' specification. Again, Appellants respectfully assert that the cited passages in Curtis do not teach the above-cited claim limitation.

Further, the Examiner asserts that a reusable OME is a new environment. Examiner's Answer, pages 8-9. Appellants respectfully traverse. The Examiner's argument on pages 8-9 simply deduces that an environment (e.g., OME) as defined in Curtis may be the same as an environment as defined in Appellants' Specification. The Examiner has not shown that a reusable OME is the same as a new environment. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 11, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- B. Response to Examiner's argument that Curtis and Yokote, taken together, teach "responsive to a determination that creation of a new environment is a best response, creating a new environment for the second program" as recited in claim 1 and similarly in claim 11, as discussed on pages 9-10 of Examiner's Answer.

The Examiner asserts that Curtis teaches "responsive to a determination that creation of a new environment is a best response, creating a new environment for the second program" as recited in claim 1 and similarly in claim 11, without providing any evidence. The Examiner asserts that Curtis teaches an environment is started if a reusable OME cannot be used. Examiner's Answer, page 9. Appellants respectfully assert that it is more accurate to state that Curtis teaches that if a reusable OME is

unavailable, the process advances to starting of a reusable OME and the connection of the task to it. Column 6, lines 30-33. Curtis further teaches that if the task cannot utilize a reusable OME, then the process starts a transitory OME and the connection of the task to it. Column 6, 38-41. Hence, Curtis teaches that if a task cannot utilize a reusable OME, then a transitory OME is started and the task becomes connected to the transitory OME. Starting a transitory OME is not the same as creating a new environment. The Examiner cites column 1, lines 16-39 and column 1, line 40 – column 2, line 5 of Curtis as evidence that the teaching of a transitory OME in Curtis is the same as creating a new environment. However, there is no language in the cited passages that teaches such a proposition. Neither is there any language in the cited passages that teaches starting a transitory OME (Appellants understand that the Examiner asserts that starting a transitory OME teaches creating a new environment) in response to determining that starting a transitory OME is the best response in response to initiation of a second program. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 11, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

In summary, the Examiner concludes that Curtis teaches the above-cited claim limitation without providing any evidence. Examiner's Answer, page 10. Since the Examiner has not shown that Curtis and Yokote, taken singly or in combination, teach or suggest the above-cited claim limitation, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 1 and 11. M.P.E.P. §2143.

- C. Response to Examiner's argument that Curtis and Yokote, taken together, teach "responsive to a determination that creating a new environment is not a best response, testing the pool for a best fit environment" as recited in claim 1 and similarly in claim 11, as discussed on pages 10-11 of Examiner's Answer.

The Examiner, in support of his assertion that Curtis and Yokote teach "responsive to a determination that creating a new environment is not a best response, testing the pool for a best fit environment" as recited in claim 1 and similarly in claim 11, asserts that Appellants are reading limitations of the Specification into the claims in their

arguments presented in Appellants' Third Appeal Brief. Examiner's Answer, page 11. The Examiner is mistaken. Appellants are not proposing the Examiner read any limitations of the Specification into the claims. Instead, Appellants simply pointed out that the Specification can be used as a dictionary to learn the meaning of a term in the patent claim. *Toro Co. v. White Consol. Indus., Inc.*, 190 F.3d 1295, 1299, 53 U.S.P.Q.2d 1065, 1067 (Fed. Cir. 1999). This is not reading limitations of the specification into the claim. Appellants simply pointed this out to the Examiner so that the Examiner understands that the Examiner has the burden of providing a basis in fact and/or technical reasoning to support the assertion that determining whether the pool of unnamed OMEs is empty, as taught in Curtis, is the same as testing the pool for a best fit environment as defined in the Specification. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Further, the Examiner states:

Applicant's specification details the testing involves other possible criteria that are evident to those skilled in the art (page 11, lines 14-17). Therefore, there is no limit to how one interprets the testing functionality. Curtis' use of testing each OME in the pool would constitute a testing of the pool for a best fit environment by one of skill in the art and therefore, the combination properly meets the claim limitations. Examiner's Answer, page 11.

Appellants respectfully traverse the assertion that there is no limit on how one interprets testing the pool for a best environment. Instead, Appellants' Specification states that in one embodiment, the test may be based on a maximum size setting for the environment pool. Page 10, lines 11-12. Appellants' Specification further states that if the maximum size has been reached, it is a best response to attempt to locate a nearly-matching preinitialized environment. Page 10, lines 12-14. Appellants' Specification further states that other possible criteria will be evident to those skilled in the art—for example, it may be better in some cases to stall certain program tasks until a free environment becomes available. Page 10, lines 14-17. There is no language in

Appellants' Specification that would cause one of ordinary skill in the art to interpret testing the pool for a best environment to mean anything the Examiner wants.

Furthermore, the Examiner is ignoring claim language. The above-cited claim limitation does not simply recite "testing the pool for a best environment." Instead, the above-cited claim limitation recites "responsive to a determination that creating a new environment is not a best response, testing the pool for a best fit environment." All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Since the Examiner has not cited to any passage in either Curtis or Yokote as teaching the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 1 and 11. M.P.E.P. §2143.

Furthermore, the Examiner states:

Curtis' use of testing each OME in the pool would constitute a testing of the pool for a best fit environment by one of skill in the art and therefore, the combination properly meets the claim limitations. Examiner's Answer, page 11.

Appellants respectfully assert that the Examiner is mischaracterizing the teaching of Curtis. Curtis teaches determining whether the pool of unnamed reusable OMEs is empty and if the pool is not empty, selecting the next reusable OME from the list of OMEs. Column 7, lines 33-56. The passage cited by the Examiner in connection with the above-cited claim limitation (column 7, lines 33-56 of Curtis) does not teach testing each OME in the pool as asserted by the Examiner. Further, the Examiner must provide a basis in fact and/or technical reasoning to support the assertion that column 7, lines 33-56 of Curtis may be interpreted as "responsive to a determination that creating a new environment is not a best response, testing the pool for a best fit environment." See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that column 7, lines 33-56 of Curtis may be interpreted as "responsive to a determination that creating a new

environment is not a best response, testing the pool for a best fit environment," and that it be so recognized for persons of ordinary skill. See *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 11. M.P.E.P. §2143.

- D. Response to Examiner's argument that Curtis and Yokote, taken together, teach "adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program" as recited in claim 1 and similarly in claim 11, as discussed on pages 11-12 of Examiner's Answer.

The Examiner has previously cited column 1, line 66 – column 2, line 21; column 11, line 39 – column 12, line 30; column 17, lines 63-67; column 18, lines 1-14; and column 18, lines 15-45 of Yokote as teaching "adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program" as recited in claim 1 and similarly in claim 11. The Examiner now cites column 7, lines 6-31 of Yokote as teaching the above-cited claim limitation. Examiner's Answer, pages 11-12. Appellants respectfully traverse.

Yokote instead teaches that the time for downloading all of the objects for the execution environment can be made to seem less to the user by first downloading only the objects necessary for executing the application program from the objects comprising the execution environment. Column 7, lines 9-13. Yokote further teaches that incremental downloading means downloading the application program or execution environment in units of objects or portions thereof comprising the application program or execution environment as necessary rather than downloading at one time. Column 7, lines 15-19. There is no language in the cited passage that teaches adding elements to the best fit environment. Neither is there any language in the cited passage that teaches adding elements to the best fit environment to match requirements of the second program. Neither is there any language in the cited passage that teaches adding elements

to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 11, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- E. Response to Examiner's argument that Curtis and Yokote, taken together, teach "wherein at least one least recently used of the first, new and best fit environments is eligible to be deleted" as recited in claim 5 and similarly in claim 15, as discussed on pages 12-13 of Examiner's Answer.

The Examiner states:

The claim limitation, broadly interpreted as proper under M.P.E.P. 2111, details that either one of the least recently used environments is deleted. It does not require one to compare the environments to one another to determine which is the least recently used which be Applicant's intent and thereby improperly incorporated as detailed in M.P.E.P. 2111. Curtis teaches the user consulting a pool of unnamed reusable OMEs to determine if an OME is available and compatible (col. 7, lines 33-67; figure 5B). If the OME is not compatible, the OME is deleted and another is created (figure 5B, element 470 and 472). Curtis inherently allows for the pool to contain only one OME due to the check perform if the pool is empty. Therefore, since the OME of the pool is deleted, the least recently used best fit environment (i.e. the only environment in the pool) is deleted. Therefore, the Examiner believes that Curtis teaches a least recent used best fit environment is eligible to be deleted. Examiner's Answer, pages 12-13.

Appellants respectfully traverse the assertion that Appellants' arguments presented on page 13 of Appellants' Third Appeal Brief somehow may be construed as proposing the Examiner to read limitations of the Specification into the claims. Appellants simply assert that the passages cited by the Examiner (Examiner cited column 6, lines 7-27 and column 8, lines 36-49 of Curtis as teaching "wherein at least one least recently used of the first, new and best fit environments is eligible to be deleted" as recited in claim 5 and similarly in claim 15) teach the possibility of an OME being discarded as well as the deletion of a reference to an OME. Appellants' Third Appeal

Brief, page 13. Appellants further asserted that there was no language in the cited passages that teaches that at least one recently used of the first, new and best fit environments is eligible to be deleted. Appellants' Third Appeal Brief, page 13. Hence, Appellants did not propose that the Examiner should read limitations of the Specification into the claims.

Further, the Examiner is now citing to a new passage (column 7, lines 33-67 and Figure 5B) of Curtis as allegedly teaching "wherein at least one least recently used of the first, new and best fit environments is eligible to be deleted" as recited in claim 5 and similarly in claim 15. Examiner's Answer, page 12. Appellants respectfully traverse. Curtis instead teaches determining whether or not the pool of unnamed reusable OMEs is empty. Column 7, lines 40-41. Curtis further teaches that if the pool is not empty, the process then advances to block 460 (selection of the next reusable OME from the list of OMEs). Column 7, lines 41-43. Additionally, Curtis teaches that afterwards, a determination of whether or not the reusable OME selected is marked as active is depicted in block 462. Column 7, lines 43-45. Furthermore, Curtis teaches that if the OME is active, control passes to block 463, which depicts a determination as to whether any more OME remain in the list. Column 7, lines 46-48. Curtis further teaches that if the reusable OME selected is not marked as active, then a determination of whether or not the task can utilize the reusable OME is made. Column 7, lines 49-51. There is no language in the cited passage to support the Examiner's interpretation of Curtis as discussed on the bottom of page 12 of Examiner's Answer.

Further, Appellants respectfully traverse the assertion that Curtis inherently allows for the pool to contain only one OME due to the check perform if the pool is empty as asserted by the Examiner. Examiner's Answer, page 12. The Examiner has not provided any basis in fact and/or technical reasoning to support such an assertion. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Curtis inherently allows for the pool to contain only one OME due to the check perform if the pool is empty. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat.

App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Curtis inherently allows for the pool to contain only one OME due to the check perform if the pool is empty, and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5 and 15. M.P.E.P. §2143.

Appellants further traverse the Examiner's conclusion that Curtis in essence inherently teaches "wherein at least one least recently used of the first, new and best fit environments is eligible to be deleted" as recited in claim 5 and similarly in claim 15. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Curtis inherently teaches "wherein at least one least recently used of the first, new and best fit environments is eligible to be deleted." *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Curtis inherently teaches "wherein at least one least recently used of the first, new and best fit environments is eligible to be deleted," and that it be so recognized for persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5 and 15. M.P.E.P. §2143.

- F. Response to Examiner's argument that Curtis and Yokote, taken together, teach "wherein the elements are parameters of at least one of the first, the new and the best fit environments" as recited in claim 6 and similarly in claim 16, as discussed on page 13 of Examiner's Answer.

The Examiner has previously cited column 1, line 66 – column 2, line 21; column 11, line 39 – column 12, line 30; column 17, lines 63-67; column 18, lines 1-14; and column 18, lines 15-45 of Yokote as teaching "wherein the elements are parameters of at least one of the first, the new and the best fit environments" as recited in claim 6 and

similarly in claim 16. The Examiner now cites column 7, lines 6-31 and column 9, line 40 – column 10, line 13 of Yokote as teaching the above-cited claim limitation. Examiner's Answer, page 13. Appellants respectfully traverse.

Yokote instead teaches that the time for downloading all of the objects for the execution environment can be made to seem less to the user by first downloading only the objects necessary for executing the application program from the objects comprising the execution environment. Column 7, lines 9-13. Yokote further teaches that incremental downloading means downloading the application program or execution environment in units of objects or portions thereof comprising the application program or execution environment as necessary rather than downloading at one time. Column 7, lines 15-19. Yokote further teaches that a downloaded object can expand the object of the client as necessary. Column 9, lines 40-41. Yokote further teaches that the necessary objects are then migrated (shifted) from the execution environment so as to become the objects at the execution environment. Column 9, lines 44-47. Yokote further teaches that a new execution environment for the necessary expansion of real-time scheduling is generated at the client and necessary objects are shifted over to the new environment. Column 9, lines 53-56.

There is no language in the cited passages that teaches that the elements added to the best fit environment are parameters. Neither is there any language in the cited passages that teaches that the elements added to the best fit environment are parameters of at least one of the first, the new and the best fit environments. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6 and 16, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- G. Response to Examiner's assertion that the Examiner's motivation is sufficient to establish a *prima facie* case of obviousness in modifying Curtis to include the missing claim limitations of claims 1 and 11, as discussed on pages 14-15 of Examiner's Answer.

The Examiner asserts that Appellants asserted in Appellants' Third Appeal Brief that the prior art must provide the same reason as Appellants to make the claimed invention. Examiner's Answer, page 14. Appellants have not made any such statement. The Examiner is transmogrifying the meaning of Appellants' words. Appellants simply assert that the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998); Appellants' Third Appeal Brief, pages 17-18. The Examiner's motivation does not provide such reasons, and hence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-18 as discussed in Appellants' Third Appeal Brief, pages 17-19. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998);

Further, the Examiner now offers a different motivation than previously presented for modifying Curtis to include the limitation of "adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program" as recited in claim 1 and similarly in claim 11. The Examiner's motivation is now "to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program (col. 9, lines 53-67)." Examiner's Answer, page 15. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 1-18.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to

establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner's motivation ("to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program") does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Curtis to add elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-18. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, the Examiner cites column 9, lines 53-67 of Yokote in support of his motivation. Column 9, lines 53-67 of Yokote does not support the Examiner's motivation ("to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program"). Instead, Yokote teaches that a new execution environment for the necessary expansion of real-time scheduling is generated at the client and necessary objects are shifted over to the new environment. Column 9, lines 53-56. Yokote further teaches that the object can therefore be made capable of receiving a real-time scheduling service without necessitating any changes. Column 9, lines 56-58. There is no language in the cited passages that supports the

Examiner's motivation of constructing the execution environments by the necessary expansion of execution environments without necessitating changes to the program. As a result, the Examiner's cited passages do not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Curtis to include the missing claim limitations of claims 1 and 11. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-18. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Curtis addresses the problem of reducing the initialization time necessary to provide a data processing environment for a particular task. Column 1, lines 40-42; Column 1, lines 51-54. The Examiner has not provided any reasons as to why one skilled in the art would modify Curtis, which teaches reducing the initialization time necessary to provide a data processing environment for a particular task, to include the aspect of adding elements to the best fit environment to match requirements of the second program, unless the best fit environment already matches the requirements of the second program (Examiner admits that Curtis does not teach this limitation). As previously mentioned, the Examiner's motivation for modifying Curtis to include the above-cited claim limitation is "to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program." However, the Examiner has not provided any rationale connection between constructing the execution environments by the necessary expansion of execution environments without necessitating changes to the program (Examiner's motivation) with the problems addressed by Curtis (reducing the initialization time necessary to provide a data processing environment for a particular task). That is, the Examiner's motivation does not provide reasons as to why one skilled in the art would modify Curtis, that overcomes the problems of having a long initialization time to provide a data processing environment for a particular task, to include the aspect of adding elements to the best fit environment to match requirements of the second program. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-18. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

- H. Response to Examiner's assertion that the Examiner's motivation is sufficient to establish a *prima facie* case of obviousness in modifying Curtis to include the missing claim limitations of claims 6 and 16, as discussed on page 15 of Examiner's Answer.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner now provides a motivation (previously did not present a motivation) for modifying Curtis to include the limitation of "wherein the elements are parameters of at least one of the first, the new and the best fit environments" as recited in claim 6 and similarly in claim 16. The Examiner states that the motivation for modifying Curtis to include the missing claim limitations of claims 1 and 11 is also used for modifying Curtis to include the missing claim limitations of claims 6 and 16. Examiner's Answer, page 15. Hence, the Examiner's motivation for modifying Curtis to include the missing claim limitations of claims 6 and 16 is "to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program (col. 9, lines 53-67)." Examiner's Answer, page 15. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 6 and 16.

The Examiner's motivation ("to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the

program") does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Curtis to have elements that are parameters of at least one of the first, the new and the best fit environments. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, the Examiner cites column 9, lines 53-67 of Yokote in support of his motivation. Column 9, lines 53-67 of Yokote does not support the Examiner's motivation ("to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program"). Instead, Yokote teaches that a new execution environment for the necessary expansion of real-time scheduling is generated at the client and necessary objects are shifted over to the new environment. Column 9, lines 53-56. Yokote further teaches that the object can therefore be made capable of receiving a real-time scheduling service without necessitating any changes. Column 9, lines 56-58. There is no language in the cited passages that supports the Examiner's motivation of constructing the execution environments by the necessary expansion of execution environments without necessitating changes to the program. As a result, the Examiner's cited passages do not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Curtis to include the missing claim limitations of claims 6 and 16. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Curtis addresses the problem of reducing the initialization time necessary to provide a data processing environment for a particular task. Column 1, lines 40-42; Column 1, lines 51-54. The Examiner has not provided any reasons as to why one skilled in the art would modify Curtis, which teaches reducing the initialization time necessary to provide a data processing environment for a particular task, to include the aspect of having elements that are parameters of at least one of the first, the new and the best fit

environments (Examiner admits that Curtis does not teach this limitation). As previously mentioned, the Examiner's motivation for modifying Curtis to include the above-cited claim limitation is "to construct the execution environments by the necessary expansion of execution environments without necessitating changes to the program." However, the Examiner has not provided any rationale connection between constructing the execution environments by the necessary expansion of execution environments without necessitating changes to the program (Examiner's motivation) with the problems addressed by Curtis (reducing the initialization time necessary to provide a data processing environment for a particular task). That is, the Examiner's motivation does not provide reasons as to why one skilled in the art would modify Curtis, that overcomes the problems of having a long initialization time to provide a data processing environment for a particular task, to include the aspect of having elements that are parameters of at least one of the first, the new and the best fit environments. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

I. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Third Appeal Brief and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION

For the reasons stated above and in Appellants' Third Appeal Brief, Appellants respectfully assert that the rejections of claims 1-6, 9 and 10 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-18.

Respectfully submitted,

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